

REMARKS/ARGUMENTS

Summary of the Office Action:

Claims 1-50 are pending in the application, prior to amendment.

Claims 1-7, 10-40, and 42-50 have been rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Pat. No. 6,277,064 to Yoon ("Yoon").

Claims 8-9 and 41 have been rejected under 35 U.S.C. § 103(a) as unpatentable over Yoon in view of U.S. Pat. Pub. No. 2004/0122290 A1 to Irion et al. ("Irion et al.").

Applicant's Response:

A. With reference to the 35 U.S.C. § 102(b) rejection of claims 1-7, 10-40, and 42-50, independent claim 1 has been amended to clarify the claimed invention in reciting "a flexible elongate body" and an articulating element which "is configured to articulate from an in-line position to an off-axis position relative to the working axis of the elongate body." Independent claim 44 has been similarly amended.

On the other hand, Yoon shows and describes a device having "an elongate, rigid tubular body 60 with longitudinal axis" wherein the offset endoscope "has a rigid transverse connecting member 58 rigidly connected to and extending laterally from the distal end." (Yoon, 4: 43-49; Figs. 1a-1b.) Therefore, the device of Yoon cannot be said to have a flexible elongate body, as recited in the claims.

Moreover, Yoon further describes the rigid transverse member of his device as providing "a fixed offset of a selected transverse dimension for positioning the offset endoscope image receiving element" (Yoon, 5: 4-9.) Because the transverse member is formed into a fixed

configuration, when Yoon's device is inserted into a patient body, the offset endoscope is positioned "as shown in FIG. 7a to lie within a diametrical dimension of surgical instrument barrel 12 by rotating the shaft ... so as to lie within a circle having the outer diameter of the barrel 12" (Yoon, 7: 32-40; Fig. 7a.)

That is, Yoon's endoscope rotates about its shaft with the offset portion fixed in its rigid configuration such that the offset portion is configured to always remain in an "off-axis" position. Rather, Yoon relies on rotating the entire shaft to articulate the rigid offset portion into position and therefore cannot articulate from an in-line position to an off-axis position relative to a working axis of the elongate body, as recited in the claims.

Therefore, amended independent claims 1 and 44, are patentable over Yoon for at least these reasons and dependent claims 2-7, 10-30, 42-43, and 45-50 depend ultimately from claims 1 and 44, respectively, and are patentable over Yoon for at least the same reasons.

With respect to independent claim 31, the Office Action states "the apparatus of Yoon is considered to be inherently capable of performing the recited method claims." (Office Action, p. 4.) However, "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." MPEP §2112. Furthermore, "[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art." *Id.*

Accordingly, the Office Action fails to provide such a basis in fact and/or technical reasoning to show that the apparatus of Yoon is inherently capable of performing the recited method of claim 31. Moreover, as mentioned above, Yoon fails to show or describe "articulating

the articulatable element from a position in-line with a working axis of the elongate body to a position out-of-line with the working axis”, as recited in the amended claim 31.

Therefore, amended claim 31 is patentable over Yoon for at least these reasons and dependent claims 32-40 depend ultimately from claim 31 and are patentable over Yoon for at least the same reasons

Accordingly, Applicants respectfully request the reconsideration and withdrawal of the rejections of claims 1-7, 10-40, and 42-50 under 35 U.S.C. § 102(b) by Yoon.

B. With reference to the 35 U.S.C. § 103(a) rejection of claims 8-9 and 41, claims 8-9 depend ultimately from independent claim 1 and claim 41 depends ultimately from independent claim 31. Therefore, claims 8-9 and 41 are patentable over Yoon, either alone or in combination with Irion et al. or any other reference, for at least the same reasons above.

Accordingly, Applicants respectfully request the reconsideration and withdrawal of the rejection of claims 8-9 and 41 under 35 U.S.C. § 103(a) by Yoon in view of Irion et al.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,

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